UNITED STATES PATENT AND TRADEMARK OFFICE

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10/786,596	02/26/2004	Daniel Y. Fung	028635-12	4371

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EXAMINER
WONG, ERIC TAK WAI

ART UNIT	PAPER NUMBER
3693	

NOTIFICATION DATE	DELIVERY MODE
10/29/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/786,596	FUNG ET AL.
	Examiner	Art Unit
	ERIC T. WONG	3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 August 2008*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-5,9-18,20-22 and 26-29* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-5, 9-18, 20-22 and 26-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date *6/19/2008*.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Examiner's note: Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the **entire** reference as potentially teaching all or part of the claimed invention, as well as the content of the passage as taught by the prior art or disclosed by the Examiner.

2.   Claims 1, 3-5, 16-17, 20, 22, 26-29 rejected under 35 U.S.C. 103(a) as being

unpatentable over Checchio (US Patent No. 6,052,675) in view of D'Agostino (US Patent No.

6,324,526), further in view of Berke (US Patent No. 6,629,092).

3.   Regarding claims 1 and 26-29, Checchio teaches authenticating the user at the server

via a device of the user while the user is at an online or offline site of the merchant; transmitting

via the user device activation information for activating a reusable, pre-existing, unaltered and

permanent credit or debit card account number of the user from the user device to the financial

institution for processing financial transactions, while the user is authenticated and based on a

selection of the merchant by the user on the server (see FIG. 1A step S9); submitting a payment

request including the reusable, pre-existing, unaltered and permanent credit or debit card

account number to the financial institution from the merchant, while the reusable, pre-existing,

unaltered and permanent credit or debit card account number is activated (see FIG 1B, step

S15); and de-activating the reusable, pre-existing, unaltered and permanent credit or debit card

account number after the payment request is processed by the financial institution, wherein the

financial institution only accepts and processes payment requests received from merchants

while the reusable, pre-existing, unaltered and permanent credit or debit card account number is

activated, and the financial institution declines payment requests while the reusable, pre-

existing, unaltered and permanent credit or debit card account number is deactivated (see

abstract).

4.   Checchio does not explicitly teach wherein the payment request comprises a recurring

payment request or a partial payment request and the method further comprises processing the

partial payment request including generating subsequent activation and deactivation information

by the server based on the selection of the merchant by the user for processing remaining

payments or processing the recurring payment request including generating subsequent

activation and deactivation information by the server based on the selection of the merchant by

the user for processing recurring payments, and the subsequent activation information does not

require the authenticating step. D'Agostino teaches a method for pre-authorizing repeating

transactions which includes pre-authorizing transactions wherein payments may be

automatically accessed by a merchant over a predetermined or unspecified time interval (such

as every thirty days) for a specific amount of a maximum dollar amount limit (see column 3 lines

55-65, column 8 lines 29-46). Therefore, it would have been obvious to one skilled in the art at

the time of invention to modify the method of pre-authorizing transactions of Checchio to include

wherein the payment request comprises a recurring payment request or a partial payment

request and the method further comprises processing the partial payment request including

generating subsequent activation and deactivation information by the server based on the

selection of the merchant by the user for processing remaining payments or processing the

recurring payment request including generating subsequent activation and deactivation

information by the server based on the selection of the merchant by the user for processing

recurring payments, and the subsequent activation information does not require the

authenticating step. One skilled in the art would have been motivated to make the modification

because it would have been convenient to the customer.

5.   Checchio does not explicitly teach transmitting the activation information directly to a

financial institution. D'Agostino teaches transmitting the activation information directly to a

financial institution (see column 3 lines 15-23, column 5 lines 42-52). Therefore, it would have

been obvious to one skilled in the art at the time of invention to modify the method of pre-

authorizing transactions of Checchio to include transmitting the activation information directly to

a financial institution. One skilled in the art would have been motivated to make the modification

for increased security.

6.   Checchio does not explicitly teach providing via a server an identification of both online

and offline merchants for selection by a user. Berke teaches providing via a server an

identification of both online and offline merchants for selection by a user (see column 2 lines 38-

45). Therefore, it would have been obvious to one skilled in the art at the time of invention to

modify the method of pre-authorizing transactions of Checchio further with providing via a server

an identification of both online and offline merchants for selection by a user. One skilled in the

art would have been motivated to make the modification for increased convenience to the user.

7.   Regarding claim 3, Checchio teaches authenticating the user with the user device (see

abstract).

8.   Regarding claim 4, Checchio teaches wherein the activation information is automatically

transmitted to the financial institution when the user logs into the server (see column 4 lines 57-

65).

9.   Regarding claim 5, Checchio teaches wherein the result of the processing of the
financial transaction is transmitted to the user via the server (see FIG 1B steps S19 and S17).

10.   Regarding claim 16, Checchio teaches wherein the user authentication includes at least
one of authentication of the user based on a user name and password of the user,
authentication based on biometric information of the user, and authentication of the user based
on personal identification number information of the user (see abstract).

11.   Regarding claim 17, Checchio teaches wherein the de-activating of the permanent credit
or debit card account number is performed at the financial institution after the processing of the
payment request (see abstract).

12.   Regarding claim 20, Checchio teaches transmitting the reusable, pre-existing, unaltered
and permanent credit or debit card account number from the user device to a device of the
merchant for processing the payment request (see FIG.1A step S1).

13.   Regarding claim 22, Checchio teaches reading the permanent credit or debit card
account number from a card via a card reader device of the merchant for processing the
payment request (see column 5 line 60 - column 6 line 4).

14.   Claims 10 and 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Checchio
in view of D'Agostino, further in view of Berke, further in view of McAllister (US Patent No
5,513,250).

15.   Regarding claim 10, McAllister teaches using a unique user name and password in the
authenticating step (see column 12 lines 40-47). Therefore, it would have been obvious to one
skilled in the art at the time of invention to modify the method of pre-authorizing transactions of

Cheechio to include using a unique user name and password in the authenticating step. One

skilled in the art would have been motivated to make the modification for increased security.

16.   Regarding claim 11, McAllister teaches de-activating the credit or debit card account

number a predetermined amount of time after the user is authenticated (see column 3 lines 8-9).

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify

the method of pre-authorizing transactions of Checchio to include de-activating the credit or

debit card account number a predetermined amount of time after the user is authenticated. One

skilled in the art would have been motivated to make the modification for increased security.

17.   Claims 9, 12-15, 18, 21 rejected under 35 U.S.C. 103(a) as being unpatentable over

Checchio in view of D'Agostino, further in view of Berke, further in view of Flitcroft (US PG-Pub

2003/0028481 A1).

18.   Regarding claim 9, Checchio does not explicitly teach wherein the activation information

is transmitted as one of a secure signal, an encrypted e-mail message, a secure facsimile

message, a secure wireless communications message, a secure telephone communications

message, a secure SMS message, and a secure web services message. Flitcroft teaches using

secure communication between the user and financial institution (see paragraph 125).

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify

the method of pre-authorizing transactions of Checchio to include wherein the activation

information is transmitted as one of a secure signal, an encrypted e-mail message, a secure

facsimile message, a secure wireless communications message, a secure telephone

communications message, a secure SMS message, and a secure web services message.

19.   Regarding claim 12, Flitcroft teaches creating a unique credit or debit card with a limited

available balance based on the credit or debit card account number of the user; and allowing

the user to execute financial transactions subject to the available balance using the unique

credit or debit card in place of the permanent credit or debit card account number (see abstract).

Therefore, it would have been obvious to one skilled in the art to modify the method of pre-

authorizing transactions of Checchio to include creating a unique credit or debit card with a

limited available balance based on the credit or debit card account number of the user; and

allowing the user to execute financial transactions subject to the available balance using the

unique credit or debit card in place of the permanent credit or debit card account number. One

skilled in the art would have been motivated to make the modification for increased security.

20.   Regarding claim 13, Checchio teaches authenticating at the server; and transmitting

from the server the activation information to the financial institution for processing of the

payment request, wherein the financial institution processes online and offline payment requests

received from merchants while the unique credit or debit card is activated and declines payment

requests while the unique credit or debit card is de-activated (see abstract).

21.   Regarding claim 14, D'Agostino teaches wherein the payment requests comprises

partial payment requests and the method further comprises processing the partial payment

requests including generating subsequent activation information for processing remaining

payments (see column 3 lines 55-65, column 8 lines 29-46). As discussed in the rejection of

claim 1, it would have been obvious to one skilled in the art to modify Checchio to accommodate

for partial payment requests because it is convenient to the customer.

22.   Regarding claim 15, D'Agostino teaches wherein the payment requests comprises

recurring payment requests and the method further comprises processing the recurring payment

requests including generating subsequent activation information for processing the recurring

payments (see column 3 lines 55-65, column 8 lines 29-46). As discussed in the rejection of claim 1, it would have been obvious to one skilled in the art to modify Checchio to accommodate for recurring payment requests because it is convenient to the customer.

23.   Regarding claim 18, Checchio does not explicitly teach wherein the financial institution includes web services for processing the activation information and the user device is enabled to access the web services of the financial institution for transmitting the activation information. Flitcroft teaches wherein the financial institution includes web services for processing the activation information and the user device is enabled to access the web services of the financial institution for transmitting the activation information (see paragraph 127). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the method of pre-authorizing transactions of Checchio further with wherein the financial institution includes web services for processing the activation information and the user device is enabled to access the web services of the financial institution for transmitting the activation information. One skilled in the art would have been motivated to make the modification for added convenience to the customer.

24.   Regarding claim 21, Flitcroft teaches storing credit or debit card account numbers on a user device via a secure mechanism (see paragraphs 131-134). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the method of pre-authorizing transactions of Checchio further with storing the credit or debit card account number on a user device via a secure mechanism. One skilled in the art would have been motivated to make the modification for added convenience to the customer.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC T. WONG whose telephone number is 571-270-3405. The examiner can normally be reached on Monday-Friday 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/   ERIC T. WONG
Supervisory Patent Examiner, Art Unit 3693   Examiner
                                                     Art Unit 3693

October 6, 2008